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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:

Marcus Peinado et al.

Serial No.: 09/482,725

Group Art Unit: 3625

Filing Date: January 13, 2000

Examiner: Cuong H. Nguyen

For: **DIGITAL LICENSE AND METHOD FOR OBTAINING / PROVIDING A DIGITAL LICENSE**

I, Steven H. Meyer, Registration No. 37,189 certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on March 24, 2003.

Registration No: 37,189

Assistant Commissioner  
for Patents  
Washington, D.C. 20231

Dear Sir:

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GROUP 3600

**REQUEST FOR RECONSIDERATION**

The following Request for Reconsideration is submitted in response to the Office Action issued on December 23, 2002 (Paper No. 5) in connection with the above-identified patent application, and is being filed within the three-month shortened statutory period set for a response by the Office Action<sup>1</sup>.

<sup>1</sup> Note that the three-month shortened statutory period ends on March 24, 2003 inasmuch as March 23, 2003 is a Sunday.

Claims 106-279 are pending in the present application, and stand rejected. Applicants respectfully request reconsideration and withdrawal of the rejection of such claims.

Preliminarily, Applicants note that the Disposition of Claims section on the coversheet of the present Office Action is inconsistent with the state of the application and the contents of the Office Action. In particular, the Disposition of Claims section incorrectly notes that claims 1-279 are pending, claims 1-105 have been withdrawn from consideration, claims 106-279 are objected to, and claims 215-231 are subject to restriction / election. Applicants respectfully submit that in point of fact, claims 106-279 are pending, none of such claims have been withdrawn from consideration, claims 106-279 stand rejected by the present Office Action, and such Office Action details no restriction or election requirement with regard to claims 215-231.

The Examiner notes that the application was filed with informal drawings and that corrections to the drawings are required as indicated by the Draftsperson. Accordingly, such corrected formal drawings are being filed with the Draftsperson under separate cover. A copy of the corrected formal drawings is also enclosed herewith.

The Examiner has specifically rejected claims 106, 150, and 173 under 35 USC § 101 for the reason that such claims are directed to non-statutory subject matter. The Examiner has also objected to dependent claims 107-149, 151-172, and 174-197 for depending on rejected base claims, but has not likewise rejected such claims under § 101. Applicants respectfully traverse the §101 rejection or object as it may be applied to claims 106-197.

Preliminarily, Applicants respectfully submit that the § 101 rejection is *prima facie* improper in that the Examiner has failed to specifically apply the Examination Guidelines for Computer-Related Inventions, or at least has not applied such Guidelines in any coherent manner.

Independent claim 106 recites a method for obtaining a digital license for rendering a piece of digital content. In the method a license requestor contacts a license provider and sends a license request for the license to the contacted license provider. The license provider then checks the license request for validity and both parties negotiate terms and conditions for the requested license. The license provider then generates the requested license and issues same to the license requestor. Independent claims 150 and 173 recites substantially the same subject matter although from the point of view of the license requestor and the license provider, respectively.

The Examiner states that the invention as recited in the claims is merely an abstract idea. However, Applicants respectfully point out that according to the Guidelines, such claims are in fact statutory subject matter.

In particular, claims 106-197 recite a series of steps that are or can be performed on a computer (Box 8 of the Guidelines flowchart). Accordingly, the issue according to Box 12 of the guidelines flowchart is whether the recited process performs independent physical acts OR whether the recited process manipulates data representing physical objects or activities to achieve a practical application. Although Applicants can argue that the answer here is yes, Applicants instead choose to presume for the sake of argument that the answer is no, and therefore proceed to Box

13, where the issue becomes whether the recited process merely manipulates abstract idea or solves a purely mathematical problem without any limitation to a practical application.

Applicants respectfully submit that the answer to Box 13 is no, and that therefore the recited process is statutory subject matter (Box 14). In particular, Applicants argue that the recited process does not merely manipulate an abstract idea or solve a purely mathematical problem. Instead, the process solves a very real and very practical problem: how to provide a digital license from a provider to a requestor such that the requestor can render corresponding digital content with the license. Moreover, Applicants respectfully submit that it is beyond argument that the solution to such practical problem as represented by the recited process in claims 106, 150, and 173 represents a practical application.

In fact, providing a digital license to render digital content that exists in an encrypted rights-protected form represents a huge application to which the employer of the Applicants (and Assignee of the present application) has expended tremendous amounts of research and capital on. Briefly, being able to perform such licensing in a trusted manner is the cornerstone of being able to distribute encrypted digital content, including but not limited to selling digital audio content and digital multimedia content to consumers. Accordingly, and again, Applicants respectfully submit that the process recited in claims 106-197 does not merely manipulate an abstract idea or solve a purely mathematical problem without any limitation to a practical application, and that

therefore such claims 106-197 in fact recite statutory subject matter according to the Examination Guidelines for Computer-Related Inventions.

Accordingly, and for all of the aforementioned reasons, Applicants respectfully submit that claims 106-197 recite patentable subject matter under section 101. Thus, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection.

The Examiner has rejected claims 232-279 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. According to the Examiner, the rejected claims call for an article of manufacture / product (a computer-readable medium), but the claims are recited in terms of method steps. According to the Examiner, such claims are therefore ambiguous as reciting both a product and process. Applicants respectfully traverse the §112, second paragraph rejection.

Independent claim 232 and 255 each recite a computer readable medium having computer-executable instructions for performing a method. The method of claim 232 is essentially that of independent claim 150, while the method of claim 255 is essentially that of independent claim 173.

Thus, Applicants respectfully submit that claims 232-279 are of the form of computer-readable medium claims that recite a product (the computer-readable medium) as having computer-executable instructions thereon, where the instructions are for performing a method. The form of such computer-readable medium claims is well-known and has been in use for many years now, and has specifically been ruled as

an appropriate format for a patent claim, at least by In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995).

Moreover, according to at least MPEP 2173.05(p), a claim that recites a product in terms of method steps, such as a product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. Significantly, 2173.05(p) allows that a claim to a device, apparatus, manufacture, or composition of matter may contain a reference to a process without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process. By the same rationale, a computer-readable medium claim that recites a product in terms of the method steps performed by instructions on the product should also be proper as long as it is clear that the claim is directed to the medium and not the method steps<sup>2</sup>. Applicants respectfully submit that claims 232-279 are clear in this regard.

Accordingly, and for all of the aforementioned reasons, Applicants respectfully submit that claims 232-279 do in fact particularly point out and distinctly claim the subject matter of the present application under section 112, second paragraph. Thus, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph rejection.

The Examiner has rejected claims 106-279 under 35 USC § 103(a) as being obvious over Wyman (U.S. Patents Nos. 5,745,879 and 5,204,897) and Krishnan (U.S. Patent No. 6,073,124) in view of Stefik (U.S. Patent No. 5,715,403), and further in

view of the "Official Notice". Applicants respectfully traverse the § 103(a) rejection of claims 106-279.

Independent claims 106, 150, 173, 232, and 255 have been summarized above. Independent claim 198 recites a digital license for rendering a piece of digital content on a device having a public key and a private key. The digital content has a content ID, is encrypted, and is decryptable with a decryption key (KD). The digital license has the content ID of the digital content, a license rights description specifying terms and conditions that must be satisfied before the digital content may be rendered, and the decryption key (KD) for decrypting the digital content. Such decryption key is encrypted with the public key of the device (PU(KD)). Thus, the device can apply the private key thereof to (PU(KD)) to obtain the decryption key (KD). Independent claim 215 recites a computer-readable medium having a data structure thereon that essentially embodies the digital license of independent claim 198.

Applicants respectfully submit that the § 103(a) rejection is *prima facie* improper for several reasons that result in Applicants not clearly understanding the bases of the rejection of the claims under § 103(a), and that because the rejection is *prima facie* improper, Applicants are unable to fully respond to the § 103(a) rejection. Under the circumstances, then, Applicants limit their remarks in response to the § 103(a) rejection to comments regarding why the rejection is *prima facie* improper and why the Applicants cannot be expected to clearly understand the bases of the rejections, inasmuch as any substantive comments on the rejection could be

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<sup>2</sup> Even though the medium is defined according to the method steps embodied in the instructions thereon.

unnecessarily construed as creating prosecution history estoppel with regard to such claims.

Firstly, Applicants do not clearly understand the bases of the rejection of the claims under § 103(a) inasmuch as the citation of the “Official Notice” at page 4, number 7 of the Office Action as a reference for rejecting claims 106-279 is ambiguous and imprecise. In particular, Applicants are unsure as to what the “Official Notice” is, or is referring to. Applicants have carefully reviewed all 13 pages of the text of the Office Action, and cannot find anywhere therein an instance where the Examiner does in fact take Official Notice of anything. Applicants respectfully submit that they are unable to respond to the rejection of claims 106-279 under section 103(a) until the Examiner clearly specifies exactly what the Examiner is taking “Official Notice” of and how such Official Notice in combination with the four cited references makes obvious such claims 106-279.

Secondly, Applicants do not clearly understand the bases of the rejection of the claims under § 103(a) inasmuch as the Examiner is citing to claim elements that are not present in any of claims 106-279. In particular, and turning now to the details of the § 103(a) rejection , it is seen that the Examiner asserts (at about pages 4-7) that the cited references disclose a content server, a license server, and a computer, even though none of claims 106-279 recite such elements. Such disconnects continue, with the Examiner asserting (at about pages 7-9) that a plethora of items are known, even though the Examiner provides no indication whatsoever that any of such multiple items is being asserted with respect to a particular one of claims 106-279. Moreover, and

significantly, the Examiner provides no basis for making such assertions, citing none of the cited references nor any other source with specificity. Applicants cannot be expected to understand or respond to the Examiner's Section 103(a) rejection without such information.

Thirdly, Applicants do not clearly understand the bases of the rejection of the claims under § 103(a) inasmuch as the Examiner in stating a case for the § 103(a) rejection does not appear to refer to many if any of the actual elements and limitations recited in claims 106-279. For example, several independent claims require that a license provider checks a license request for validity, and several independent claims require that a license provider and a license requestor both negotiate terms and conditions for a requested license. However, nowhere in the bases for the rejection are such claim elements discussed or even alluded to. Once again, Applicants cannot be expected to understand or respond to the Examiner's Section 103(a) rejection without such basic information.

Fourthly, the Examiner at or about page 9 ambiguously states that all claimed limitations are capabilities of cited computer systems, and that methods of use of such systems are obvious. According to the Examiner, "cited prior art limitations are not necessary (sic) spelled-out exactly claimed languages, (sic)" because these prior references are also directed to a similar system for digital rights management. The Examiner continues with similar ambiguous generalities well into page 10. Applicants respectfully submit that such blanket statements cannot satisfy the requirement that the Examiner make a *prima facie* case of obviousness under Section 103(a). In particular,

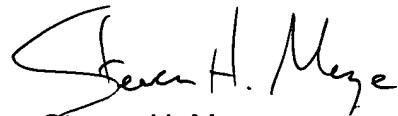
Applicants respectfully point out that such blanket statements amount to a blanket rejection of the claims without providing any specific details. Moreover, such blanket statements do not at all provide any indication of why the cited references should or could be combined to produce the invention recited in the claims.

Further, Applicants respectfully submit that a proper rejection cannot be based merely on the fact that computer systems exist and can therefore be programmed in a manner to produce the invention recited in the claims, as the Examiner implies. Such a rejection amounts to an argument that the present invention is inherent in a computer system. With regard to "inherent", then, Applicants direct the Examiner's attention to MPEP § 2112, where it is discussed that a rejection based on inherency is proper under Section 102 only and not under Section 103. Moreover, inherency can be established only by extrinsic evidence that makes it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Applicants respectfully submit that based on all of the above reasons, the Examiner has not clearly set forth a *prima facie* basis for explaining the manner in which the Wyman references and the Krishnan reference should or could be modified in view of the Stefik reference and the "Official Notice" to produce the invention recited in claims 106-279. Moreover, without such explanation of how the references are

In view of the foregoing discussion, Applicants respectfully submit that the present application, including claims 106-279, is in condition for allowance, and such action is respectfully requested. Should the Examiner disagree, Applicants respectfully request that the Examiner telephone the undersigned at the number below to arrange an in-person interview with the Examiner and the Examiner's supervisor to discuss the present Office Action.

Respectfully submitted,



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Date: March 24, 2003

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